

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MAY 2, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Research and Education Association

Serial No. 75/362,651

Max Fogiel, President of Research & Education Association
for applicant.

Chad T. O'Hara, Trademark Examining Attorney,
Law Office 113
(Meryl Hershkowitz, Managing Attorney)

Before Hanak, Bottorff and Rogers, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Research and Education Association (applicant) seeks
to register THE VERY BEST COACHING & STUDY COURSE FOR THE
SAT I in typed drawing form for "a series of educational
books featuring college entrance test preparation
materials." The application was filed on September 12,
1997 with a claimed first use date of December 1993.

The Examining Attorney refused registration on two grounds. First, citing Section 2(d) of the Trademark Act, the Examining Attorney contends that applicant's mark, as applied to applicant's goods, is likely to cause confusion with the mark SAT, previously registered in typed drawing form for "printed tests and test booklets." Registration No. 1,067,655. Second, citing Section 2(e)(1) of the Trademark Act, the Examining Attorney contends that applicant's mark is merely descriptive of applicant's goods.

Both applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

We will first consider whether there is likelihood of confusion resulting from the contemporaneous use of applicant's mark and the registered mark. In any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the accumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Considering first the goods, the evidence of record establishes that they are closely related. Registrant's

goods are printed tests and test booklets, and applicant's goods are educational books featuring college entrance test preparation materials. Indeed, as applicant's specimens of use make clear, its educational books are specifically designed to assist students in preparing for registrant's SAT college admission tests. In addition, the Examining Attorney has made of record third-party registrations demonstrating that the same marks have been registered for both tests and educational books.

Applicant does not dispute the foregoing. Indeed, applicant concedes that "applicant provides books to help students in preparing to take the SAT examination."

(Applicant's brief page 2). However, applicant argues that because the "registrant's goods [the SAT tests] are not available on the market to be compared with applicant's goods, there can be no confusion between the goods."

(Applicant's brief page 2). Two comments are in order. First, applicant has provided no evidentiary support of any kind to establish that registrant's goods are not available "on the market." It could well be the case that registrant makes available to students copies of its old SAT tests.

Second, if we assume for the sake of argument that registrant does not make available copies of its old SAT tests, a student or his/her parents could easily assume

that the entity which prepares the test (registrant) is the same entity which makes available educational books to study for the test. Indeed, the aforementioned third-party registrations demonstrate that it is a common practice for the same entity to offer both test and tests preparation materials.

Finally, as for applicant's argument that a number of other companies market educational books with titles which incorporate registrant's mark SAT, we simply note that there is nothing in the record to indicate whether registrant has given its approval to these other companies. Moreover, even if assume for the sake of argument that registrant has not acted to prevent applicant and others from using the term SAT in the titles of their books, this does not mean that registrant has agreed to allow applicant and others to register titles of a series of books containing registrant's mark SAT.

One final comment is in order. We would be remiss if we did not note that after the term SAT in applicant's mark there appears an asterisk, which then makes reference to the following statement: "SAT is a registered trademark of the College Entrance Examination Board [registrant] which does not endorse this book." Many of the competing educational books submitted by applicant contain similar

disclaimers. If there was no likelihood of confusion resulting from the contemporaneous use of applicant's mark on educational books and registrant's SAT on printed tests, then presumably there would be no need for the disclaimer which applicant has placed on the front cover of its books.

Turning to a consideration of the marks, it would appear at first blush that applicant's eleven word mark and registrant's one word mark are quite dissimilar. However, it must be remembered that applicant seeks to register its mark in typed drawing form. Thus, in our likelihood of confusion analysis, we must consider all reasonable manners in which applicant could depict its mark, and in particular, we must consider all manners in which applicant has actually depicted its mark. Phillips Petroleum v. C.J. Webb, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971); INB National Bank v. Metrohost, 22 USPQ2d 1585, 1588 (TTAB 1992). Reproduced below is the top portion of the cover of applicant's educational book showing how applicant actually depicts its mark.

As is readily apparent, the manner in which applicant actually depicts its mark clearly emphasizes the SAT portion of applicant's mark. The words THE VERY BEST COACHING & STUDY COURSE FOR THE are depicted in an extraordinarily subordinate fashion. A student viewing applicant's educational book would readily see the word SAT, and may not even notice the remaining wording of applicant's mark, namely, THE VERY BEST COACHING & STUDY COURSE FOR THE. Moreover, if the student did notice this very subordinate wording, said wording may only increase the likelihood of confusion because the student may be under the assumption that this particular educational book is the "official" study book for the SAT endorsed by registrant. The wording THE VERY BEST COACHING & STUDY COURSE FOR THE is highly laudatory and may be taken to indicate that this educational book is the very best because it is the official book.

In short, we find that there exists a likelihood of confusion resulting from the contemporaneous use of applicant's mark on educational books and registrant's mark on tests.

We consider next whether applicant's mark is merely descriptive of applicant's goods. In making this determination, we have the benefit of a recent decision of

our primary reviewing Court. See In re Boston Beer Co. L.P., ___ F.3d ___, 53 USPQ2d 1056 (Fed. Cir. 1999). As the Court made clear, "marks that are merely laudatory and descriptive of the alleged merit of a product are also regarded as being descriptive..." 53 USPQ2d at 1058. In Boston Beer, the Court found that the alleged mark THE BEST BEER IN AMERICA for beer was "so highly laudatory and descriptive of the qualities of its product that the slogan does not and could not function as a trademark to distinguish Boston Beer's goods and serve as an indication of origin." 53 USPQ2d at 1058. If anything, applicant's purported mark is even more laudatory and descriptive in that it is THE VERY BEST COACHING & STUDY COURSE FOR THE SAT I (emphasis added).

Indeed, it appears now that applicant does not seriously dispute that its mark is highly laudatory and highly descriptive of its educational books. In this regard, we note that applicant has belatedly attempted to seek the benefits of Section 2(f) of the Trademark Act by claiming that its mark has now become distinctive of its goods through use. This Board, in orders dated October 20, 1999 and February 24, 2000, rejected applicant's attempt to belatedly claim the benefits of Section 2(f). Nevertheless, applicant's attempt to do so is only further

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evidence that applicant itself recognizes that its mark is highly laudatory and highly descriptive of its educational books.

Decision: The refusals to register pursuant to Sections 2(d) and 2(e)(1) of the Trademark Act are affirmed.

E. W. Hanak

C. M. Bottorff

G. F. Rogers
Administrative Trademark
Judges, Trademark Trial
and Appeal

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